

**REMARKS**

Applicant submits that the present application, as currently amended, is in condition for allowance.

Claims 1-26 are pending, with claims 1-12 and 14-25 amended by the present amendment.

In the Official Action, Claims 1, 2, 10, 14, 15 and 23 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4 and 7 of U.S. Patent No. 7,287,393; claims 1, 2, 10, 14, 15 and 23 were rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 12 of U.S. Patent No. 7,082,353; claims 1, 2, 10 and 14 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8 and 14 of U.S. Patent No. 7,062,927; claims 1-6, 8-19 and 21-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by Chiles et al. (U.S. Patent Publication No. 2001/0036192, hereinafter Chiles); and claims 7 and 20 were rejected under 35 U.S.C. § 103(a) and being unpatentable over Chiles in view of Kaplan et al. (U.S. Patent No. 6,141,339, hereinafter Kaplan).

Claims 1-12 and 14-25 are amended to avoid an interpretation under 35 U.S.C. § 112, sixth paragraph, and to comply with 35 U.S.C. § 112, second paragraph. Independent claims 1 and 14 are further amended to clarify that the indoor and outdoor units are air conditioning units. Support for this amendment is found in Applicant's originally filed specification. No new matter is added.

As a first point of order, Applicant traverses the current double patenting rejections. The present application was filed in the U.S. on December 9, 2003, whereas the patents applied in the

double patenting rejections were filed in the U.S. in 2004. Because the present application was filed before these patents, Applicant submits that the two-way obviousness test should be applied. Applicant further submits that upon application of the two-way obviousness test, the pending claims are not obvious.

MPEP 804 notes that if the patent is the later filed application, a two-way test is to be applied only when a) the Applicant could not have filed the claims in a single application *and* b) there is administrative delay.<sup>1</sup> Furthermore, in the absence of administrative delay, a one-way test is appropriate.<sup>2</sup> Unless the record clearly shows administrative delay by the Office and that Applicant could not have avoided filing separate applications, the examiner may use the one-way obviousness determination and shift the burden to Applicant to show why a two-way obviousness determination is required.

Thus, the first question to be addressed is whether or not Applicant could have filed the claims in a single application. *In re Berg* describes the special circumstances which trigger the two-way test. Here, the court notes that Berg relied on Braat to support application of the two-way test; and that Braat was an unusual case with a factual situation that is not likely to be repeated since the 1984 Act went into effect. However, the court went on to note that the two-way test could apply if under the current law "...an Applicant could not have filed both sets of claims in one application -- for example, because the second application claimed an invention that was not adequately disclosed in the first application." Here, Applicant submits that each of the patents in question disclose and recite features not disclosed in the present application (e.g., the electricity charge calculator recited in claim 1 of the '927 patent; the peak power processor

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<sup>1</sup> *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998).

<sup>2</sup> *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

recited in claim 1 of the '393 patent; and the synchronization processor and controller recited in claim 1 of the '353 patent.) Because each of the later filed applications claim an invention that was not adequately disclosed in the present application, Applicant could not have filed both sets of claims in one application.

Berg goes on to note that if, on the other hand, an Applicant could not have filed both sets of claims in one application "but the first application was delayed in prosecution causing the second application to issue as a patent first, then one would expect that the "control test" as discussed in Borah would be applied to determine whether the Applicant or the PTO is responsible for the delay....The two-way test may be appropriate, however, in the unusual circumstance that the PTO is solely responsible for the delay in causing the second-filed application to issue prior to the first."

Here, Applicant submits that the PTO is solely responsible for the delay in causing the second-filed application to issue prior to the first. The current Office Action is the first action since the application was filed in 2003. Applicant has taken no action to delay the prosecution of the present application.

In view of the preceding comments, Applicant submits that the two-way test is applicable. MPEP 804 further notes that when making a two-way obviousness determination, it is necessary to apply the *Graham* obviousness analysis twice, once with the application claims as the claims in issue, and once with the patent claims as the claims in issue. Where a two-way obviousness determination is required, an obvious-type double patenting rejection is appropriate only where each analysis compels a conclusion that the invention defined in the claims in issue is an obvious variation of the invention defined in a claim in the other application/patent. If either

analysis does not compel a conclusion of obviousness, no double patenting rejection of the obvious-type is made, but this does not necessarily preclude a nonstatutory double patenting rejection based on the fundamental reason to prevent unjustified timewise extension of the right to exclude granted by a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Here, Applicant submits that the unique circumstances of *In re Schneller* do not apply. Furthermore, each of the patents in question disclose and recite features not disclosed in the present application (e.g., the electricity charge calculator recited in claim 1 of the '927 patent; the peak power processor recited in claim 1 of the '393 patent; and the synchronization processor and controller recited in claim 1 of the '353 patent.) Thus, the claims of the '927, '393 and '353 patent are not obvious in view of the claims of the present application. Because this reverse analysis does not compel a conclusion of obviousness, no double patenting of the obvious-type is present. Thus, the current double-patenting rejections are moot.

Turning now to the rejection under 35 U.S.C. § 102(e), amended claim 1 is directed to:

An integrated controlled multi-air conditioner system, comprising:

a plurality of groups of indoor air conditioning units;

a plurality of outdoor air conditioning units, each of said plurality of outdoor air conditioning units connected with one of said plurality of groups of indoor air conditioning units;

at least one local controller connected in common with said plurality of outdoor air conditioning units over an internal network and configured to control operations of said plurality of outdoor air conditioning units; and

a protocol conversion device connected with said local controller, said protocol conversion device configured to convert different communication protocols of data transmitted and received between an external Internet network and said internal network into each other to transfer a control command received over said external Internet network to at least one of said plurality of outdoor air conditioning units.

With Applicant's claimed invention, plural air conditioning units (e.g., air conditioning units associated with an apartment building) may be efficiently controlled from a remote location.

Chiles describes a system where home-networked appliances are connected to a host system. An example of a client device is an HVAC system.<sup>3</sup> The host system 330 may include one or more gateways that connect and therefore link complexes, such as the OSP host complex gateway 375 and the IM host complex gateway 385. The OSP host complex gateway 375 and the IM host complex gateway 385 may directly or indirectly link the OSP host complex 370 with the IM host complex 380 through a wired or wireless pathway. Ordinarily, when used to facilitate a link between complexes, the OSP host complex gateway 375 and the IM host complex gateway 385 are privy to information regarding a protocol anticipated by a destination complex, which enables any necessary protocol conversion to be performed incident to the transfer of data from one complex to another. For instance, the OSP host complex 370 and IM host complex 380 may use different protocols such that transferring data between the complexes requires protocol conversion by or at the request of the OSP host complex gateway 375 and/or the IM host complex gateway 385.<sup>4</sup>

However, Chiles does not disclose or suggest Applicant's claimed plurality of groups of indoor air conditioning units and plurality of outdoor air conditioning units, each of the plurality of outdoor air conditioning units connected with one of the plurality of groups of indoor air conditioning units; and at least one local controller connected in common with the plurality of outdoor air conditioning units over an internal network and configured to control operations of

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<sup>3</sup> Chiles, paragraph [0035].

<sup>4</sup> Chiles, paragraph [0049].

the plurality of outdoor air conditioning units, as recited in independent claim 1. Thus, Chiles also does not disclose or suggest Applicant's claimed protocol conversion device.

Similarly, Chiles does not disclose or suggest Applicant's claimed plurality of groups of indoor air conditioning units, plurality of outdoor air conditioning units, plurality of local controllers, and plurality of protocol conversion devices, as recited in amended claim 14.

MPEP § 2131 notes that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Chiles does not disclose or suggest all of the features recited in claims 1 and 14, Chiles does not anticipate the invention recited in claims 1 and 14, and all claims depending therefrom.

Applicant has considered Kaplan and submits that Kaplan does not cure the deficiencies of Chiles. As none of the cited art, individually or in combination, discloses or suggests at least the above-noted features of independent claims 1 and 14, Applicant submits the inventions defined by claims 1 and 14, and all claims depending therefrom, are not rendered obvious by the asserted references for at least the reasons stated above.<sup>5</sup>

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<sup>5</sup> MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations.

Conclusion

In view of the above remarks, it is believed that claims now distinguish over the art relied by the Examiner either alone or in combination. In view of this favorable reconsideration of the rejection and allowance of all the claims is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael E. Monaco, Reg. No. 52, 041, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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